

**REMARKS**

Applicants respectfully traverse the rejection of claims 1-4, 6-10, 12, 14, 15, 19-28, and 30-33 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,357,042 to Srinivasan et al. ("*Srinivasan*") in view of U.S. Patent No. 6,177,931 to Alexander et al. ("*Alexander*").

The Office Action fails to articulate where *Srinivasan* and *Alexander* allegedly teach or suggest, alone or in combination, a data transmission method comprising, inter alia, "at the viewer apparatus, processing software stored in a data storage medium at the viewer apparatus based on the operation signal to generate first output content data, without requiring any transmission to the transmitter," as recited in claim 1 (emphasis added).

Furthermore, even the combination of teachings from *Srinivasan* and *Alexander* that is suggested by the Examiner fails to include a data transmission method comprising, inter alia, "outputting an operation signal based on an operation performed by a viewer at the viewer apparatus; [and] at the viewer apparatus, processing software stored in a data storage medium at the viewer apparatus based on the operation signal to generate first output content data, without requiring any transmission to the transmitter," as recited in independent claim 1.

*Srinivasan* discloses "[a]n authoring system for interactive video . . . for providing authored metadata to be related to a main video data stream and a multiplexer for relating authored metadata from the authoring sources to the main video data stream." *Srinivasan* at Abstract. "[A]s an example, [illustrated in FIG. 16,] when a client at premise **205** decides to purchase a scheduled program (VOD) from a cable company,

his profile may be communicated, by prior arrangement, to the cable company by ad server **221**. Based on the provided profile, video ads may be selectively pulled or pushed from Internet-connected servers such as server **211** . . .” *Id.* at col. 33, lines 21-27. Referring to FIG. 7, “[a]uthoring system **51** receives [video] stream **49** for the purpose of authoring the [video] stream . . . Due to a unique synchronous architecture . . . , the resulting output streams, shown here as stream **53** (video stream) and stream **55** (annotation stream) may ultimately reach end users such as users **48a-n** via broadcast with minimal or no delay.” *Id.* at col. 13, lines 21-22 and lines 27-33. “Separate data streams (video and annotation) are given frame-specific identification and marking so that they may latter be synchronized by using inserted data corresponding to the frame-specific identification.” *Id.* at col. 18, lines 8-11.

However, *Srinivasan* does not teach or suggest “processing software stored in a data storage medium at the viewer apparatus based on the operation signal to generate first output content data, without requiring any transmission to the transmitter,” as recited in claim 1 (emphasis added). For example, transmitting a video-on-demand (VOD) request to a cable company does not constitute “processing software stored in a data storage medium at the viewer apparatus,” as required by claim 1. *Srinivasan* is silent as to any “software” being “processed” as part of transmitting a VOD request. Furthermore, transmitting the VOD request to the cable company constitutes a transmission to a transmitter, namely a transmission of the VOD request to the cable company. Thus, *Srinivasan* fails to teach or suggest “processing software stored in a data storage medium at the viewer apparatus based on the operation signal to generate

first output content data, without requiring any transmission to the transmitter,” as recited in claim 1.

*Alexander* does not make up for the deficiencies of *Srinivasan*. *Alexander* is silent as to “processing software stored in a data storage medium at the viewer apparatus,” as recited in claim 1 (emphasis added). The Examiner only relies on *Alexander* to allegedly teach performing a processing step “without requiring any transmission to the transmitter,” as recited in claim 1. Office Action, page 3, paragraphs 3 and 4. However, combining the teachings of *Alexander* with those of *Srinivasan* would nevertheless require a transmission to a transmitter. *Alexander* teaches, “customized [advertising] messages can be preloaded by zip code into the memories of particular viewers [Electronic Programming Guides].” *Alexander* at col. 32, lines 45-47. However, storing advertisements at a viewer’s terminal does not obviate the requirement for the system of *Srinivasan* to send video-on-demand (VOD) requests back to the cable company in order to receive VOD programming. Indeed, the term “on-demand” refers to requesting a program from the cable company when the user desires to watch the program. Thus, *Srinivasan* and *Alexander* do not teach or suggest, alone or in combination, “processing software stored in a data storage medium at the viewer apparatus based on the operation signal to generate first output content data, without requiring any transmission to the transmitter,” as recited in claim 1.

Moreover, there is no reason one of ordinary skill at the time of the invention would have combined *Srinivasan* and *Alexander* as suggested by the Examiner. *Srinivasan* and *Alexander* teach away from the Examiner’s suggested combination because such a combination would produce a seemingly inoperative device.

*Srinivasan* teaches, “[s]eparate data streams (video and annotation) are given frame-specific identification and marking so that they may latter be synchronized by using inserted data corresponding to the frame-specific identification.” *Srinivasan* at col. 18, lines 8-11 (emphasis added). However, if the video stream (53) and annotation stream (55) were generated at two separate locations, “without requiring any transmission” from one location to the other, as apparently suggested by the Examiner, then the system of *Srinivasan* would not be capable of giving the separate video stream (53) and annotation stream (55) frame-specific identification and marking such that these streams (53, 55) could later be synchronized. As shown in FIG. 7 of *Srinivasan*, the authoring system (51) must receive video stream (49) in order to generate an annotation stream (55) with frame-specific identification relative to video stream (53), since this frame-specific identification makes synchronization possible at the end users (48a-n). Since the system of *Srinivasan* does require a transmission to a transmitter in order to permit synchronization, modifying the *Srinivasan* system to omit this transmission, as apparently suggested by the Examiner, would produce a seemingly inoperative device.

Accordingly, the Examiner’s suggested combination of *Srinivasan* and *Alexander* fails to teach or suggest all of the elements recited in claim 1. There would also not have been any suggestion or motivation for one of ordinary skill at the time the invention was made to combine *Srinivasan* and *Alexander* as suggested by the Examiner since such a combination would produce a seemingly inoperative device. Furthermore, the Examiner has not identified any reason why one of ordinary skill would otherwise modify *Srinivasan* and *Alexander*, either alone or in combination, to obtain all of the elements

recited in claim 1. Thus, since *Srinivasan* and *Alexander* do not render obvious the method recited in claim 1, claim 1 is allowable over *Srinivasan* and *Alexander*.

Independent claims 10, 19, 20, 22, and 26 are allowable over *Srinivasan* and *Alexander* for reasons similar to those explained above in relation to claim 1. Thus, because claims 6-9 depend from claim 1; claims 12, 14, and 15 depend from claim 10; claim 21 depends from claim 20; claims 23-25 depend from claim 22; and claims 27, 28, and 30-33 depend from claim 26, claims 1-4, 6-10, 12, 14, 15, 19-28, and 30-33 should be allowed over *Srinivasan* and *Alexander* and this rejection should be withdrawn.

Applicants respectfully traverse the rejection of claims 16-18 under 35 U.S.C. § 103(a) as unpatentable over *Srinivasan* in view of *Alexander*, and further in view of U.S. Patent Application Publication No. 2003/0133043 to Carr ("*Carr*"). Independent claim 16 is allowable over *Srinivasan* and *Alexander* for reasons similar to those explained above in relation to claim 1.

*Carr* does not make up for the deficiencies of *Srinivasan* and *Alexander*. Thus, claim 16 and claims 17 and 18, which depend therefrom, should be allowed over *Srinivasan*, *Alexander*, and *Carr*.

Applicants respectfully traverse the rejection of claims 5, 13, and 29 under 35 U.S.C. § 103(a) as unpatentable over *Srinivasan* in view of *Alexander*, and further in view of U.S. Patent No. 6,425,825 to Sitrick ("*Sitrick*"). Claims 5, 13, and 29 depend from claims 1, 10, and 26, respectively, and *Sitrick* does not make up for the deficiencies of *Srinivasan* and *Alexander* in relation to claims 1, 10, and 26. Thus, claims 5, 13, and 29 should be allowed over *Srinivasan*, *Alexander*, and *Sitrick*.

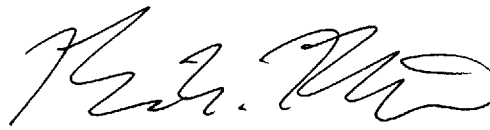
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 18, 2008

By: 

Reece Nienstadt  
Reg. No. 52,072